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FACSIMILE COVER LETTER

To:	SPE Gary Kunz
Firm:	UNITED STATES PATENT AND TRADEMARK OFFICE
Facsimile:	(571) 273-8300
From:	Howard C. Lee Reg. Patent Agent, Reg. No. 48,104
Date:	October 17, 2005
Re:	U.S. Patent Appln. Serial No. 10/049,410 for "HERBICIDAL COMPOSITIONS COMPRISING POST-EMERGENCE HERBICIDES FOR SOIL APPLICATION" Applicant(s): Udo BICKERS et al. FLH Ref. No.: 514413-3911
Number of Pages:	6 (including cover page)

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Confirm. No. 1061
514413-3911

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Udo BICKERS et al.
Serial No.	:	10/049,410
Filing Date	:	7 February 2002
For	:	HERBICIDAL COMPOSITIONS COMPRISING POST-EMERGENCE HERBICIDES FOR SOIL APPLICATION
Examiner	:	Alton N. Pryor
Art Unit	:	1616

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (571) 273-8300 on the date shown below.

Howard Cutler
Type or print name of person signing certification

Howard Cutler
Signature

October 17, 2005
Date of Signature

EXPEDITED PROCEDURE
RESPONSE AFTER FINAL ACTION
UNDER 37 C.F.R. 1.116

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION
UNDER 37 C.F.R. §1.181(a) WITH PETITION FOR EXTENSION OF TIME

Mail Stop: AF (SPE Gary Kunz to decide petition)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Examiner's Answer dated 15 July 2005, setting a two month term for reply.

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PETITION FOR EXTENSION OF TIME

Pursuant to the provisions of 37 C.F.R. §1.136(a)(1), applicants hereby petition for an extension of time of **one month** in responding to the Examiner's Answer of **15 July 2005**. Granting of Applicants' request would serve to extend Applicants' due date from 15 September 2005 to **17 October 2005** (the 15th was a Saturday).

Please charge Account No. 50-0320 in the amount of **$120** to satisfy the fee for a one (1) month extension of time. The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Account No. 50-0320.

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PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

The Examiner's Answer dated 15 July 2005 contained a new ground of rejection, i.e. the rejection of claim 18. Since the applicants have not had a fair opportunity to react to the rejection, the applicants request that prosecution on the merits be reopened.

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a ***fair opportunity to react to the rejection***. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection). see MPEP 1208.01 (emphasis added)

However, in the present application, claim 18 was NEVER subjected to a rejection as is explained in greater detail below. While the rejection of claim 18 is also over the prior art used to reject claims 14, 15 and 17, the applicants fail to see how forcing the applicants to respond to a rejection for the first time during their Reply Brief constitutes a "fair opportunity". It is noted that any such response by the applicants is still governed by the after final rejection practice of 37 C.F.R. §1.116, i.e. unlike if prosecution had been reopened, the applicants have no guarantee that any claim amendment or declarative evidence would be considered on the merits as entry of these papers is at the discretion of the Examiner (In the present application, of the three amendments after final submitted by the applicants which contained amendments to the claims, two were denied entry and another was entered only because a new ground of rejection was being made).

The applicants have put forth several bona fide efforts to conclude prosecution of this application, but the applicants have either met with delayed responses to the applicants' suggestions or changing positions by the Examiner.

The excerpt below is from the applicants second amendment under 37 CFR 1.116 ("second amendment") mailed on 3 November 2003:

"This Amendment is being filed after the undersigned made numerous telephone calls to Examiner Pryor, during which a final resolution with respect to the questions being asked by the undersigned was not provided. Applicants are extremely dissatisfied that no definitive answers with respect to the questions concerning the status of claims 14 to 16 and possible amendments to claims 1 to 7 were provided by the Office despite numerous attempts since August 4, 2003. The Examiner's inability to meaningfully contact the undersigned has caused injustices to both the Applicants and the undersigned in seeking timewise extensions, thereby shortening patent term." (From the notes left in the file, it appears that Mark Russell/Sam Megerditchian left messages for the Examiner on 10/6, 10/7, 10/16, 10/17, 10/20 and 10/23 but no return reply was received)

After this second amendment was filed, the Examiner issued an Advisory Action (dated 7 January 2004) which indicated that claim 17 was allowable (this is the same claim 17 that is currently under Appeal). A third amendment was filed which cancelled all claims except for claims 14-17 (dated 20 January 2004). Up until this point in prosecution, the rejections of the claims had been over Masayuki and Langley.

In response to the third amendment, claim 14, 15 and 17 were rejected by the Examiner over new references (Narayanan and Sanders) and claim 16 was said to be allowable if rewritten in independent form (similar to the present claim 18) - see paper dated 22 March 2004. The applicants cancelled claim 16 and reintroduced the subject matter as new claim 18, i.e. indication of allowable subject matter had switched from claim 17 to claim 16/18. The Examiner's subsequent Final Rejection dated 9 September 2004 indicated that claim 18 was allowable. This position was maintained by the Examiner during his Advisory Action of 10 January 2005. As such, the Examiner had three opportunities to reject the subject matter of claim 18 over Narayanan and Sanders but did not do so until his Examiner's Answer.

These actions undertaken by the office (four office actions on the merits and three Advisory Actions) during prosecution of this application are not in keeping with the tenets of

compact prosecution or the customer service goals set for in the PTO's FY-2004 Performance and Accountability Report. Therefore, in order to ensure that the applicants are able to present all claim amendments and declarative evidence necessary to properly decide this Appeal (should the claims not be held allowable) and also stop the accrual of extension of time costs, the applicants respectfully request that the finality of the rejection be withdrawn and that the Examiner's Answer be converted into a non-final rejection.

The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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